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OFFICE OF PETITIONS

In re Application of  
Worthington, et al.  
Application No. 09/643,106  
Filing Date: 21 August, 2000  
Attorney Docket No. 18950-30

DECISION

This is a decision on the (renewed) petition filed on 24 June, 2005, alleging unintentional delay under 37 C.F.R. §1.137(b).

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**NOTE:** There is an indication from the petition contents/supporting materials that the address of record may no longer be valid. A copy of this decision is being sent to addresses (a) of record for the Petitioner and (b) provided by Petitioner's office. Moreover, it also appears that there is no indication that Petitioner herein was ever empowered to prosecute the instant application. If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance and Fees Due mailed on 2 October, 2003, with reply (fees) due under a non-extendable deadline on or before 2 January, 2004;
- the application went abandoned after midnight 2 January, 2004;
- the Office mailed the Notice of Abandonment on 10 February, 2004;
- Petitioner filed the original petition (with fee), the Issue Fee (small entity)—the Notice of Allowance contained no indication that a publication fee was due—as the reply, and, for reasons unexplained Petitioner also paid a \$65.00 surcharge, however, in lieu of a statement of unintentional delay, Petitioner included not only his statement but that of Richard Burstein, CEO of the former and now partial assignee, and that statement was unclear as to the unintentional nature of the delay, and, thus, the petition was dismissed on 24 June, 2005, pending clarification of that matter;
- with the instant petition (with notice of loss of small entity status and supplemental payment of the issue fee) Petitioner Russell M. Jeide (Reg. No. 54,198) makes an unequivocal statement of unintentional delay, and so addresses the prior deficiency.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, the statement of unintentional delay (a further showing may be required), a proper reply, and—where appropriate--a terminal disclaimer and fee.

The record (including the petitions filed on 12 August, 2004, and 29 August, 2005) does not necessitate a finding that the delay between midnight 2 January, 2004 (date of abandonment), and 29 August, 2005 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Petitioner Russell M. Jeide (Reg. No. 54,198) when accepting Petitioner's representation that the delay in filing the response was unintentional.<sup>7</sup>

Thus, Petitioner has satisfied the requirements of the regulation.

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<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See *Changes to Patent Practice and Procedure*, 62 *Fed. Reg.* at 53160 and 53178, 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is released to Publications Branch to be processed into a patent.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

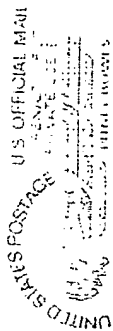
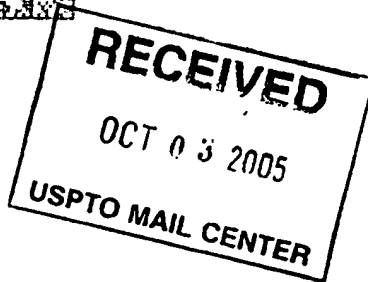
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